

REMARKS

Applicants respectfully request reconsideration of this application as amended. Claims 1, 11 and 16 have been amended. Claims 25-27 were previously cancelled without prejudice. No new claims have been added. Therefore, claims 1-24 are presented for examination.

35 U.S.C. § 103 Rejection

Claims 1-3, 8, 16-18 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schoenberg, U.S. Patent No. 6,463,417 ("Schoenberg") in view of Rozen, U.S. Patent No. 6,073,106 ("Rozen") and Rind, "Maintaining the confidentiality of medical records shared over the internet and the World Wide Web", ("Rind").

Claim 1, as amended, recites:

A method of controlling transfer of health information along a network pathway, the method comprising:
receiving, by an access server on the network pathway, a request for the health information from across an internal network, the request being generated from a portable healthcare device on the network pathway;
immediately determining, by the access server, if a corresponding consent is stored in the access server and whether the consent satisfies requirements for release of the health information, wherein the consent is for a requestor of the health information to access the health information and the consent is provided by an owner of the health information, wherein the consent is based on results provided by a filtering component, the filtering component to filter the health information based on the request such that an unnecessary portion of the health information is filtered out, wherein the request includes an intended use of the health information, wherein the intended use of the health information of the request is used to determine appropriateness of the consent or requirements for the consent, wherein a purpose field is provided to specify intended reasons for which the health information is accessed according to the consent; and
if the corresponding consent is stored, permitting, by the access server, the health information to be immediately acquired by sending the request across an external network to a remote site, receiving the health information from the remote site, and forwarding the health information back across the internal network, and electronically communicating the health information between the portable healthcare device and a health professional device, wherein communicating the health information includes one or more of prescribing prescriptions, accessing patient medical history, accessing

medical test results, submitting order claims, purchasing medicine.
(emphasis added)

Applicants respectfully disagree with the Examiner's characterization of the references and the pending claims. For example, Schoenberg discloses a "method of and system *for distributing medical information for an individual over a communications network is disclosed.* The method includes the steps of generating a plurality of security access codes, generating a plurality of hierarchical categories, ranging from a low security category to a high security category, categorizing the individual's medical information into privacy levels ranging from a least private level to a most private level, inputting the individual's categorized medical information into the plurality of hierarchical categories, the least private level being input into the low security category and the most private level being input into the high security category and assigning, to each of the categories, one or more of the access security codes, such that the medical information in each category will be released only if the assigned access security codes are received." (Abstract; emphasis added).

Referring now to the section relied upon by the Examiner (for a particular feature of claim1), Schoenberg further discloses "if the patient suffers a broken bone, *while information regarding the patient's blood type and allergies might be necessary for the proper treatment of the injury, the patient's cardiological or serological data is not. None of the above methods can prevent unnecessary medical data from being divulged to the medical care provider, thus potentially risking the patient's privacy.*" (col. 2, lines 7-10; emphasis added). This is not the same as "the request includes an intended use of the health information, wherein the intended use is to determine one or more of appropriateness of the consent, and requirements for the consent, wherein a purpose field is provided to specify intended reasons for which the health information is accessed in

according to the consent” as recited by claim 1 (emphasis added). Schoenberg does not teach or reasonably suggest at least these features of claim 1.

The Examiner acknowledges that Schoenberg does not teach or reasonably suggest all the limitations of claim 1, such as the intended use of the health information of the request is used to determine appropriateness of the consent or requirements for the consent, wherein a purpose field is provided to specify intended reasons for which the health information is accessed according to the consent as recited by claim 1. (see page 5, Office Action, mailed 12-15-08). However, the Examiner relies on Rozen and Rind for support. Applicants disagree.

For example, Rozen discloses “*[v]ia Internet communications or via phone/fax/mail*, a participant is prompted to provide a constant identifier and a selected password. Emergency and confidential categories of medical information are identified, and the *participant is prompted to provide personal information in each of the categories and a different personal identification number* (E-PIN, C-PIN) for each category.” (Abstract; emphasis). Rozen’s managing and controlling access information is **not the same as** the intended use of the health information of the request is used to determine appropriateness of the consent or requirements for the consent, wherein a purpose field is provided to specify intended reasons for which the health information is accessed according to the consent as recited by claim 1.

Claim 1, as amended, further recites “electronically communicating the health information between the portable healthcare device and a health professional device, wherein communicating the health information includes one or more of prescribing prescriptions, accessing patient medical history, accessing medical test results, submitting order claims, purchasing medicine”. (emphasis added). Schoenberg, Rozen and Rind,

neither individually nor when combined, teach or reasonably suggest at least this feature of claim 1.

Applicant respectfully traverses the aforementioned rejection for the following reasons. According to MPEP §2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Furthermore, according to MPEP §2143, "[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*." And, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).

Schoenberg, Rozen and Rind, neither individually nor when combined, teach or reasonably suggest all the features of claim 1 and a *prima facie* case of obviousness has not been met under MPEP §2142. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 1 and its dependent claims.

Claims 11 and 16 contain limitations similar to those of claim 1. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 11 and 16 and their dependent claims

Claims 4-5 and 19-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”) and Rind, “Maintaining the confidentiality of medical records shared over the internet and the World Wide Web”, (“Rind”) as applied to claims 3 and 18 above and further in view of Edelson, U.S. Patent No. 5,737,539 (“Edelson”).

Claims 4-5 and 19-20 depend from one of claims 1 and 16. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 4-5 and 19-20.

Claim 6 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”) and Rind, “Maintaining the confidentiality of medical records shared over the internet and the World Wide Web”, (“Rind”) as applied to claims 1 and 16 above, and further in view of Snowden, U.S. Patent No. 2002/0026332, (“Snowden”) and Edelson, U.S. Patent No. 5,737,539 (“Edelson”).

Claims 6 and 21 depend from one of claims 1 and 16. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 6 and 21.

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”) and Rind, “Maintaining the confidentiality of medical records shared over the internet and the World Wide Web”, (“Rind”) as applied to parent claim 1 above, and further in view of Applicant Admitted Prior Art (“AAPA”).

Claim 7 depends from claim 1. Accordingly, Applicants respectfully request the withdrawal of the rejection of claim 7.

Claims 9-13 and 23-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”) as applied to parent claims 1 and 16 above as applicable and further in view of Applicant Admitted Prior Art (“AAPA”).

Claims 9-10, 12-13 and 23-24 depend from one of claims 1, 11 and 16. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 9-10, 12-13 and 23-24.

Claims 14-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schoenberg, U.S. Patent No. 6,463,417 (“Schoenberg”) in view of Rozen, U.S. Patent No. 6,073,106 (“Rozen”) and Applicant Admitted Prior Art (“AAPA”) as applied to parent claim 11 above, and further in view of de la Huerga, U.S. Patent No. 5,903,889 (“de la Huerga”).

Claims 14-15 depend from claim 11. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 14-15.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Invitation for a Telephone Interview

The Examiner is requested to call the undersigned at (303) 740-1980 if there remains any issue with allowance of the case.

Request for an Extension of Time

Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17(a) for such an extension.

Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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/Aslam A. Jaffery/

Aslam A. Jaffery

Reg. No. 51,841

12400 Wilshire Boulevard
7th Floor
Los Angeles, California 90025-1030
(303) 740-1980